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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/616,961

07/11/2003

Yuji Sakamoto

8014-1065

2130

466

7590

07/28/2006

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EXAMINER

AHN, SANGWOO

ART UNIT

PAPER NUMBER

2166

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/616,961		SAKAMOTO, YUJI	
	<b>Examiner</b>		<b>Art Unit</b>	
	Sangwoo Ahn		2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 May 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

The amendment filed on 5/5/2006 has been entered.

Claims 1 – 7 have been canceled.

Claims 8 – 11 have been added.

Claims 8 – 11 are pending in this Office Action.

### ***Response to Arguments***

Applicant's arguments with respect to claims 8 – 11 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 – 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication Number 2003/0028796 issued to Dale T. Roberts et al (hereinafter "Roberts") in view of Japanese Patent Number JP02001189048A issued to Yoshiaki Miyazaki (hereinafter "Miyazaki").

Regarding claim 8, Roberts discloses,

An information reproducing and recording apparatus comprising:

a reproducing unit which reproduces program information pieces from a first recording medium recording a plurality of program information pieces (par 22: 9 – 13, par 34: 1 – 4, et seq.);

A recording/reproducing unit which records at least one program information piece on a second recording medium or reproduces program information pieces from the second recording medium recording a plurality of program information pieces (Figure 1: 100, par 34: 1 – 4, et seq.);

A controller which controls both of the reproducing unit and the recording/reproducing unit (Figure 1: 100 and 110, par 34, et seq.),

Wherein the controller comprises:

an order information stored in a database, the order information indicating order of record position of the program information pieces recorded on the first recording medium (The order information inherently exists because the prior art teaches TOC information and etc.);

Roberts does not explicitly disclose,

a determining device which determines whether or not program information pieces recorded on the first recording medium is recorded on the second recording medium;

a recording controlling device which controls the recording/reproducing unit, in cases it is determined that at least one program information piece out of program

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information pieces is not recorded, so that the program information piece determined not to be recorded is recorded on the second recording medium;

a reproducing controlling device which controls the recording/reproducing unit so that the program information pieces are reproduced from the second recording medium.

However, Miyazaki discloses,

a determining device which determines whether or not program information pieces recorded on the first recording medium is recorded on the second recording medium;

a recording controlling device which controls the recording/reproducing unit, in cases it is determined that at least one program information piece out of program information pieces is not recorded, so that the program information piece determined not to be recorded is recorded on the second recording medium (abstract: solution, par 9, et seq.);

a reproducing controlling device which controls the recording/reproducing unit so that the program information pieces are reproduced from the second recording medium (par 34, et seq.).

At the time of the present invention, it would have been obvious to a person of ordinary skill in the data processing art to combine the two references because Miyazaki's method of preventing a double copy would have enabled Roberts' recording recognition system to save HDD space.

Regarding claim 9, Roberts and Miyazaki disclose,

an information recording determining device which compares management information corresponding to the program information recorded on the first recording medium and management information corresponding to the program information recorded on the second recording medium, and determines whether or not the management information on the first recording medium is present on the second recording medium (Roberts: Figure 4A – 4B, par 16, 19, 22 – 23, 34, et seq.);

an attribute information acquiring device which acquires attribute information in relation to the program information in cases where it is determined that the management information on the first recording medium is not present on the second recording medium (Roberts: par 77 – 79: if comparison using unique ID derived from the TOC of the CD returns no match, text-based identification is tried, et seq.);

an attribute information recording determining device which determines, by referring a database having history information including attribute information in relation to the program information recorded on the second recording medium, whether or not the acquired attribute information is present in the database (Roberts: Figure 4A and 4C, par 22 – 23, 45 – 46, 79, 82, et seq.);

wherein the determining device (Miyazaki: abstract: solution, par 9, et seq.) determines that the program information piece recorded on the first recording medium is not recorded on the second recording medium in case where it is determined by the attribute information recording determining device that the attribute information is not present in the database (Roberts: Figure 4A – 4B, par 16, 19, 22 – 23, 24, 45 – 46, 69, 82, et seq.).

Claim 10 is essentially the same as claim 8 except it sets forth the limitation as "a method" rather than "an apparatus", therefore rejected based on the same rationale discussed in claim 8 rejection.

Claim 11 is is essentially the same as claim 8 except it sets forth the limitation as "a medium" rather than "an apparatus", therefore rejected based on the same rationale discussed in claim 8 rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sangwoo Ahn whose telephone number is (571) 272-5626. The examiner can normally be reached on M-F 10-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571)272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Sangwoo Ahn  
Patent Examiner  
AU 2166

7/14/2006 SW



**HOSAIN ALAM  
SUPERVISORY PATENT EXAMINER**